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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/017,241 | 12/14/2001 | Douglas B. Quine | F-409 | 1544 |

919 7590 04/21/2005

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EXAMINER

ENGLAND, DAVID E

ART UNIT PAPER NUMBER

2143

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/017,241 | Applicant(s) QUINE ET AL. | |
| | Examiner David E. England | Art Unit 2143 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/12/02, 11/26/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DC

DETAILED ACTION

1. Claims 1 – 29 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "likelihood", in claims 7 and 23, is a relative term, which renders the claim indefinite. The term "likelihood" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The Applicant is asked to be more descriptive in the claim language in order to not use such a broad term, (example; "in the event").

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 – 5, 7 – 21 and 23 – 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Malik U.S. Publication No. 2002/0065891.

7. Referencing claim 1, as closely interpreted by the Examiner, Malik teaches a method for correcting an e-mail address, the method comprising:

8. parsing a domain portion of the e-mail address, (e.g., ¶ 0031);

9. identifying a format requirement corresponding to the domain portion in a domain name database, (e.g., ¶ 0039 – 0040); and

10. providing a format suggestion based on the identified format, (e.g., ¶ 0039 – 0040).

11. Referencing claim 2, as closely interpreted by the Examiner, Malik teaches parsing an identifier portion of the e-mail address, (e.g., ¶ 0031 & ¶ 0042);

12. determining whether the identifier portion is consistent with the identified format requirement, (e.g., ¶ 0039 – 0040); and

13. providing an indication of whether the identifier portion is consistent with the identified format requirement, (e.g., ¶ 0039 – 0040).

14. Referencing claim 3, as closely interpreted by the Examiner, Malik teaches the step of determining further comprises:

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15. receiving addressee information about an addressee to whom a message is intended at the e-mail address, (e.g., ¶ 0039 – 0040); and

16. determining whether the addressee information is consistent with the identifier portion and the identified format requirement, (e.g., ¶ 0039 – 0040).

17. Referencing claim 4, as closely interpreted by the Examiner, Malik teaches the addressee information is a name of the addressee, (e.g., ¶ 0042 – 0043).

18. Referencing claim 5, as closely interpreted by the Examiner, Malik teaches the identified format requirement is a function of an addressee's name, and the step of determining further comprises:

19. comparing the identifier portion to a list of known names, (e.g., ¶ 0031); and

20. making a determination of whether the identifier portion is consistent with one or more known names under the identified format requirement, (e.g., ¶ 0039 – 0040).

21. Referencing claim 7, as closely interpreted by the Examiner, Malik teaches the step of making the determination further comprises:

22. utilizing a statistical frequency of the known names to determine a likelihood whether the identifier portion is consistent with one or more known names under the identified format requirement, (e.g., ¶ 0035 – 0036).

23. Referencing claim 8, as closely interpreted by the Examiner, Malik teaches the step of:

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24. providing a suggested correction that complies with the identified format requirement, (e.g., Abstract).

25. Referencing claim 9, as closely interpreted by the Examiner, Malik teaches receiving addressee information about an addressee to whom a message is intended at the e-mail address, (e.g., ¶ 0035 – 0036); and

26. wherein the step of providing the suggested correction includes generating the suggested correction based on the addressee information, (e.g., Abstract & ¶ 0008).

27. Referencing claim 10, as closely interpreted by the Examiner, Malik teaches the addressee information is a name of the addressee, (e.g., ¶ 0042).

28. Referencing claim 11, as closely interpreted by the Examiner, Malik teaches the step of gathering the addressee information from the message intended to the addressee, (e.g., ¶ 0035 – 0036).

29. Referencing claim 12, as closely interpreted by the Examiner, Malik teaches the steps of:

30. determining whether the domain portion complies with domain formulation rules, (e.g., ¶ 0039 – 0040); and

31. providing an indication whether the domain portion complies with domain formulation rules, (e.g., ¶ 0039 – 0040).

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32. Referencing claim 14, as closely interpreted by the Examiner, Malik teaches the steps of:
33. comparing the domain portion to a list of known domain names, (e.g., ¶ 0037);
34. if the domain portion is not in the list of known domain names, determining one or more known domain names for which the domain portion may be a misspelling, (e.g., ¶ 0037 & 0049);
- and
35. providing the one or more known domain names as potential alternative spellings for the domain portion, (e.g., ¶ 0037 & 0049).

36. Referencing claim 15, as closely interpreted by the Examiner, Malik teaches the steps of:
37. identifying a second format requirement corresponding to the one or more known alternative spelling domain names, (e.g., ¶ 0037 & 0049); and
38. providing a preferred alternative spelling for the domain portion based on whether the second format requirement for the one or more known alternative domain spellings is consistent with the identifier portion of the e-mail address, (e.g., ¶ 0037 & 0049).

39. Claims 13, 16 – 21 and 23 – 29 are rejected for similar reasons stated above.

Claim Rejections - 35 USC § 103

40. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

41. Claims 6 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik as applied to claims 1, 2, 5, 16 and 21 above, and in further view of Tafoya et al. (6829607), (hereinafter Tafoya).

42. As per claim 6, as closely interpreted by the Examiner, Malik does not specifically teach the identified format requirement is a function of the addressee's first name and last name, the list of known names includes first names and last names, and the step of comparing the identifier portion to a list of known names further comprises:

43. comparing a first sub-portion of the identifier portion to the list of known first names; and

44. comparing a second sub-portion of the identifier portion to the list of known last names.

Tafoya teaches the identified format requirement is a function of the addressee's first name and last name, the list of known names includes first names and last names, and the step of comparing the identifier portion to a list of known names further comprises:

45. comparing a first sub-portion of the identifier portion to the list of known first names, (e.g., col. 13, line 46 – col. 14, line 20 & Table 1 & Figure 6); and

46. comparing a second sub-portion of the identifier portion to the list of known last names, (e.g., col. 13, line 46 – col. 14, line 20 & Table 1 & Figure 6). It would have been obvious to one of ordinary skill in the art, at the time the invention was conceived, to combine Tafoya with Malik because utilizing a sub portion look-up allows efficient email addressing by minimizing users' keystrokes and mouse clicks.

47. Claim 22 is rejected for similar reasons as stated above.

Conclusion

48. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

49. a. Groner U.S. Patent No. 6507643 discloses Speech recognition system and method for converting voice mail messages to electronic mail messages.

50. b. Nielsen U.S. Patent No. 5892919 discloses Spell checking universal resource locator (URL) by comparing the URL against a cache containing entries relating incorrect URLs submitted by users to corresponding correct URLs.

51. c. Montero et al. U.S. Publication No. 2002/0143828 discloses Automatically adding proper names to a database.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England
Examiner
Art Unit 2143

De



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